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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
FOREMAN, JONATHAN M	

ART UNIT	PAPER NUMBER
3736	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/938,533	MULLER ET AL.	
	Examiner	Art Unit	
	Jonathan ML Foreman	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-9,11-21,23,28-32 and 40-54* is/are pending in the application.

4a) Of the above claim(s) *8,9,12-18 and 20* is/are withdrawn from consideration.

5)☒ Claim(s) *46-54* is/are allowed.

6)☒ Claim(s) *3-7,11,19,21,23,28-32,40-42,44 and 45* is/are rejected.

7)☒ Claim(s) *43* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 40 and 50 are objected to because of the following informalities: line 11 of claim 40 includes two commas and claim 50 is a fragment. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23 and 28 – 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regards to claim 23, "said transducer" in line 9 lacks antecedent basis. Additionally, it is unclear how a first coupling means connected to the electromechanical stimulation means and a second coupling means connected to said transducer (the electromechanical stimulation means) allow for connection with the positioning means when the positioning means has no coupling means. Essentially, it is unclear why the electromechanical stimulation means (said transducer) has a first and second coupling means.

Claim Rejections - 35 USC § 102/35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 3 – 7, 11, 19, 21 and 40 – 42 are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,788,711 to Lehner et al. or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,788,711 to Lehner et al. in view of U.S. Patent No. 6,517,476 to Bedoya et al.

In reference to claims 3 – 7, 11, 19, 21 and 40, Lehner et al. discloses providing a partially implantable hearing system (Figure 1) comprising an electromechanical output transducer (6) selected from the group consisting of electromagnetic, electrodynamic, magnetostrictive, dielectric and piezoelectric transducers (Col. 8, lines 21 - 38); a micromanipulator (1) attached to a cranial vault (Col. 6, lines 24 – 26) for rotationally and axially positioning the transducer and for fixing the transducer in a set position (Col. 6, lines 41 - 53); a releasable snap-in-locking type coupling unit disposed between the transducer and the micromanipulator (Col. 7, lines 26 - 31). The releasable coupling comprises a first coupling element (15) connected to the micromanipulator, and a second coupling element connected to the transducer (the housing of transducer), wherein the coupling elements are configured so as to enable the second coupling element to snapingly connect to the first coupling element (Col. 7, lines 26 – 31) without causing adjustment to the micromanipulator and to securely mechanically lock the second coupling element to the first coupling element, and to enable the second coupling element to be releasably disconnected from the first coupling element (Col. 7, lines 26 – 31). The micromanipulator-side coupling element comprises an at least partially circular opening and receives the transducer-side coupling element and is axially symmetrical with respect to an axis of the transducer (Figure 3). At least one of the coupling elements is partially made of an elastic, soft polymeric material (Col 7, line 29). The releasable coupling unit enables the

replacement of the transducer while maintaining the position set by the micromanipulator. Lehner et al. discloses a releasable coupling unit where the micromanipulator-side coupling element includes a rigid annular receiver and the transducer-side coupling element is adapted to snap into the receiver member. The Examiner considers the releasable coupling to be a snap-in coupling in that the transducer can be snapped into and removed from the coupling. However, if Lehner et al. fails to disclose the releasable coupling being a snap-in coupling. Bedoya et al. discloses a connector for an implanted hearing system (See Abstract) wherein the releasable coupling is a snap-in coupling having a rigid annular receiving member, and the coupling element is a soft polymeric material (Col. 2. line 40) and adapted to snap into the rigid annular receiver member in a substantially axial direction (Figure 3; Col. 7, lines 1 – 5; Col. 8, lines 56 – 63). It would have been obvious to modify the releasable coupling unit as disclosed by Lehner et al. to include a snap-in configuration as taught by Bedoya et al. in order to provide a coupling unit which provides a tight, snug fit between components and facilitate in situ selective interconnection between the micromanipulator and the transducer and allow for selective removal/repositioning of the transducer (See Abstract).

In regards to claims 41 and 42, Lehner et al. discloses fixedly attaching a micromanipulator (1) to the cranial vault of a recipient (Col. 6, lines 24 – 26), the micromanipulator having a manipulator-side coupling (15); positioning the manipulator in a desired position; releasably coupling at least one electromechanical transducer, the transducer having a transducer-side coupling element connected thereto, to the micromanipulator including snapping the transducer-side coupling element into the micromanipulator side coupling element; and allowing the transducer-side coupling element to mechanically lock therein (Col. 7, lines 26 – 31). The transducer-side coupling element is connected to the transducer during production of the transducer in that the coupling element is considered to be the housing that fits into the micromanipulator side coupling element. The

Examiner considers the releasable coupling to be a snap-in coupling in that the transducer can be snapped into and removed from the coupling. However, if Lehner et al. fails to disclose the releasable coupling being a snap-in coupling. Bedoya et al. discloses a connector for an implanted hearing system (See Abstract) wherein the releasable coupling is a snap-in coupling having a rigid annular receiving member, and the coupling element is a soft polymeric material (Col. 2. line 40) and adapted to snap into the rigid annular receiver member in a substantially axial direction (Figure 3; Col. 7, lines 1 – 5; Col. 8, lines 56 – 63). It would have been obvious to modify the releasable coupling unit as disclosed by Lehner et al. to include a snap-in configuration as taught by Bedoya et al. in order to provide a coupling unit which provides a tight, snug fit between components and facilitate in situ selective interconnection between the micromanipulator and the transducer and allow for selective removal/repositioning of the transducer (See Abstract).

7. Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,788,711 to Lehner et al. in view of U.S. Patent No. 6,517,476 to Bedoya et al.

In regards to claims 44 and 45, Lehner et al. disclose decoupling the transducer-side coupling element from the manipulator side coupling element, but fails to disclose removing the transducer from the recipient and coupling a replacement transducer to the micromanipulator. However, Bedoya et al. teaches decoupling implantable components in order to replace one or more components (Col. 1, lines 6 – 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the decoupled transducer as disclosed by Lehner et al. from the recipient and couple a replacement transducer to the micromanipulator, in order to replace broken or worn out components of the system as taught by Bedoya et al.

Response to Arguments

8. Applicant's arguments in respects with the elastic piece disclosed by Lehner have been persuasive. However, the Examiner now considers this piece to be a part of the micromanipulator side coupling element (see above).

Allowable Subject Matter

9. Claims 46 – 54 are allowed. Claim 43 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMLF